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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/993,699	12/18/97	HANEY	D HAN301F

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QM12/1206

EXAMINER

ROSE, R

ART UNIT

PAPER NUMBER

3723

DATE MAILED:

12/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 08/993699

Filing Date: 12/18/97

Appellant(s): Haney

David A. Fanning
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 9/10/99.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-2, and 6-12 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 3-5, and 13 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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The rejection of claims 14-15 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,702,287	Haney	12-1997
5,443,414	Haney	8-1995

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 14-15 stand rejected under 35 U.S.C. 112, second paragraph. This rejection is set forth in prior Office action, Paper No. 7.

Claims 1-13 stand rejected under 35 U.S.C. 101. This rejection is set forth in prior Office action, Paper No. 7.

Claims 14-15 stand rejected under 35 U.S.C. 101. This rejection is set forth in prior Office action, Paper No. 7.

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(11) Response to Argument

With regard to the rejection of claims 14-15 under 35 U.S.C. 112, second paragraph it is the examiner's position that claim 14 is incomplete in that there is no structure permitting translational orbiting motion by virtue of the rotation of the two recited shafts. There must be some additional element or means recited to convert the rotary motion of the shafts to a translational orbital motion, since any structure fixedly attached to the end of a shaft must necessarily rotate with the shaft. A "translational orbital" motion is a special case of a more general "orbital" motion, in which each point on the platen traces the same closed end curvilinear path. In order to accomplish this curvilinear translational motion there must be some structure to convert the rotational motion of the shafts to a translational motion. Simply reciting bearings on the ends of the shafts would not alone accomplish this changeover to translational motion, and in fact, on a pair of rigid straight shafts, would be inoperative, since the platen cannot follow the rotational motion of each of the shafts simultaneously. It would require further structure, such as offset portions on the shafts, or highly flexible shafts constrained to move in unison. However, no such structure has been provided in the claim. Thus, claim 14 is deemed to be incomplete. With regard to claim 15, there is lack of antecedent support for the recitation in line 4 of "the second and third shafts", as only "a drive shaft" and "two shafts supported by the brace" were previously recited.

Turning to the rejection of claims 1-13 under 35 U.S.C. 101 double patenting, Appellant argues that although the claims are virtually identical as the patented claims, they are not of the

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same scope, and relies upon the omission of the phrase "sheet of" before the term "sandpaper" in Appellants claims, which is intended to provide a broader scope. It is the examiner's position that the term "sandpaper" inherently implies a sheet, since as commonly understood, sandpaper is abrasive grit on a paper or other sheetlike substrate used in place of paper, such as cloth. Appellant has defended claims 1-13 as being patentable over his prior patent by insisting that other embodiments of "sandpaper" would not necessarily be formed as a sheet, giving roll and endless band as examples. First of all, in the examiner's view, a sheet is a sheet whether it is attached by its ends to form a band or wrapped on a drum to form a roller. However, even if these hypothetical embodiments were not considered to come under the definition of sheets, Appellant's specification, claims and drawings gives absolutely no guidance in how anything but a single layer of sandpaper could be configured to work with the disclosed platen. In other words, it is not seen how such hypothetical embodiments would be incorporated into the platen by a simple substitution for the abrasive sheet shown and disclosed therein.

With regard to the rejection of claims 14-15 under 35 U.S.C. 101 double patenting, Appellant again relies solely upon the substitution of the phrase "operatively connected" in place of the term "linked" in US 5,443,414. Appellant maintains that the term "operatively connected" somehow confers a broader meaning than the term "linked", which would prevent potential infringers from somehow getting around his patents. Again, it is the examiner's position that the terms "linked" and "operatively connected" as commonly used, are

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synonymous, and of identical scope. The term "linked" does not in any way imply that there must, of necessity, be direct physical contact between components. Thus, Appellant's claims are equivalent to those of his prior US patents.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Rose", written in a cursive style.

**ROBERT A. ROSE
PRIMARY EXAMINER
ART UNIT 323**

rr
December 5, 1999

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